



METROPOLITAN
TRANSPORTATION
COMMISSION

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Memorandum

TO: Administration Committee

DATE: October 6, 2010

FR: General Counsel

W.I.: 1151

RE: Contract Amendment – Intellectual Property Special Counsel: Hanson, Bridgett LLP

The Office of General Counsel requests this Committee's approval to enter into a contract extension with the law firm of Hanson, Bridgett to continue to act as Intellectual Property ("IP") Special Counsel for the Metropolitan Transportation Commission (MTC) and, as needed, for the Bay Area Toll Authority (BATA) and the MTC Service Authority for Freeways and Expressways (MTC SAFE) through June 30, 2014. The proposed budget for the contract extension is \$25,000 for the remainder of this fiscal year and \$35,000 per year for the three additional fiscal years.

Background

Hanson Bridgett has been MTC's intellectual property legal counsel since 1996, based on two competitive procurements conducted in 1996 and 2005. The Request for Qualifications (RFQ) issued in September 2005 authorized an initial five year contract period, beginning January 1, 2006 and an extension of up to five-years, at MTC's option. The initial contract expires on December 31, 2010. The amount spent since January 2006 is approximately \$150,000.

Hanson has advised MTC on IP matters related to ClipperSM, 511 Transit, 511 Traffic, and StreetSaver[®] (MTC's pavement management program software) and has handled all of MTC's service marks. Hanson attorneys have provided timely, high-quality work, and Garner Weng, a partner at Hanson, has been the lead attorney on this contract and its predecessor since 2001. During the past four-plus years, there has been no litigation involving IP rights. However, if MTC, BATA or SAFE were to become involved in IP-related contract disputes or litigation, Hanson would be fully capable of assisting in resolving those disputes or lawsuits. The firm regularly represents public agency clients, to whom it provides a government fee reduction of 10%.

Recommendation

Staff recommends that this Committee authorize the Executive Director or his designee to negotiate and enter into a contract amendment with Hanson Bridgett LLP to provide legal services related to intellectual property to MTC, MTC SAFE and BATA, in an amount not to exceed \$25,000 through June 30, 2011 and \$35,000 per fiscal year through June 30, 2014.

Adrienne D. Weil

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REQUEST FOR COMMITTEE APPROVAL

Summary of Proposed Contract Amendment

Work Item No.:	1151
Special Counsel:	Hanson Bridgett LLP San Francisco, CA
Work Project Title:	Intellectual Property Special Counsel
Purpose of Project:	To provide legal services on an as-needed basis in the area of intellectual property and other related matters through June 30, 2014.
Brief Scope of Work:	<ul style="list-style-type: none">• Advise the Office of General Counsel (OGC) regarding requests for proposal, contract provisions and licensing arrangements in major projects such as ClipperSM, 511 Transit and 511 Traffic;• Represent or advise MTC (and if needed MTC SAFE or BATA) in contract and license negotiations with consultants;• Handle trademark or service mark applications and registrations and prepare letters to third parties addressing possible infringements;• Draft or review nondisclosure agreements between MTC and vendors, consultants, or other agencies;• Advise OGC concerning copyright and patent rights;• Represent MTC in bringing or defending litigation concerning intellectual property;• Provide other legal advice related to IP projects.
Project Cost Not to Exceed:	\$25,000 through June 30, 2011; \$35,000 per year for FY 2011-12, 2012-13 and 2013-14.
Funding Source:	TDA, MTC SAFE, BATA
Fiscal Impact:	Funds are available in the FY 2010-11 agency budget; remaining fiscal years subject to adoption of agency budgets.
Motion by Committee:	That the Executive Director or his designee is authorized to negotiate and enter into contract amendment with Hanson Bridgett LLP to provide legal services related to intellectual property through June 30, 2014, and the Chief Financial Officer is directed to set aside funds for the contract, subject to adoption of annual agency budgets.
Administration Committee:	<hr/> Tom Bates, Chair
Approved:	Date: October 13, 2010